

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Michael Downes et al.

Title: NON-STEROIDAL FARNESOID
X RECEPTOR MODULATORS
AND METHODS FOR THE USE
THEREOF

Appl. No.: 10/535,043

Patent No. 7,671,085

Filing Date: 12/9/2005

Issue Date: 3/2/2010

Examiner: Zarek, Paul

Art Unit: 1617

Confirmation Number: 2033

**SECOND RENEWED REQUEST FOR RECONSIDERATION OF PATENT TERM
ADJUSTMENT UNDER 37 C.F.R. §1.705**

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants once again respectfully request reconsideration of the patent term adjustment (PTA) determined for the above captioned patent. This renewed request is in response to the Decision on Request for Recalculation of Patent Term Adjustment in View of Wyeth (mailed May 7, 2010) in which the previous request (submitted May 3, 2010) was dismissed.

The first renewed request for reconsideration of patent term adjustment was timely submitted on May 3, 2010 under 37 C.F.R. §1.705 as correctly specified in the document. The request for reconsideration was not intended to be an Interim Request for Recalculation under 35 U.S.C. 154(b) as suggested by the May 7th communication from the USPTO. Therefore, the

dismissal of the first renewed request for reconsideration was made in error. It is, therefore, respectfully requested that this second renewed request for recalculation be properly reviewed under 37 C.F.R. §1.705(d) and in view of the following details regarding the calculation of patent term adjustment for this patent.

In the communication mailed January 25, 2010, the USPTO indicated that the decision on Applicants' initial request was dismissed as premature until after the actual patent date. As noted above, the patent has now issued (on March 2, 2010) as U. S. Patent No. 7,671,085, thus this basis of dismissal is no longer applicable.

The Patent Office determined that the patent was entitled to 907 days of PTA. Applicants believe that this PTA determination was made in accordance with the "Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)" published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

However, on January 7, 2010, the U.S. Court of Appeals for the Federal Circuit affirmed the decision of the U.S. District Court for the District of Columbia finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute was incorrect. The correct interpretation of the statutory requirement that two types of delay have "no overlap" under 35 U.S.C. § 154 means that they must not occur on exactly the same date. *Wyeth v. Kappos*, No. 2009-1120 (Fed. Cir. Jan. 7, 2010). A PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays occur on the same day. Therefore, a patentee is entitled to PTA for both A Delay and B Delay as long as they do not overlap the same date.

Applicants have recalculated PTA for the captioned application under the court's interpretation of the PTA statute, and have determined that the patent is entitled to 1,027 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704 .

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B):	1,117 days
(b) Total Applicant delay:	90 days
Final PTA Determination:	1,027 days

Applicants therefore respectfully request that the patent be accorded 1,027 days PTA. The patent is not subject to a terminal disclaimer.

The requisite fee was previously paid along with the Request filed on August 31, 2009. While it is believed that no additional fees are due with this Renewed Petition, the Commissioner is authorized to charge any additional fees which may be required regarding this request, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Respectfully submitted,

Date 6/2/10

By Stephen E. Reiter

FOLEY & LARDNER LLP
Customer Number: 30542
Telephone: (858) 847-6711
Facsimile: (858) 792-6773

Stephen E. Reiter
Registration No. 31,192
Attorney for Applicant

Patent Term Adjustment Calculation System

Docket Number: 088802-9706
 Application Number: 10/535043
 Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Priority Date	11/15/2002	-912		
Edit Delete	International Filing Date	11/14/2003	548		
	PCT National Stage Commencement Date	05/15/2005	0		
Edit Delete	National Stage Entry (All 371(c) & (f) Requirements Met)	12/09/2005	208		
	14 month From Application date	02/09/2007	635		
	3 Year Period Starts	05/15/2008	1,096		
Edit Delete	Non-Final Office Action	08/11/2008	1,184	(549)	
	Non-Final Office Action + 3 months	11/11/2008	1,276		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	12/10/2008	1,305		29
Edit Delete	IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO	12/10/2008	1,305		
Edit Delete	Final Office Action	02/06/2009	1,363		
	Final Office Action + 3 months	05/06/2009	1,452		
Edit Delete	Final Office Action Response Received at PTO	07/06/2009	1,513		61
Edit Delete	Notice of Allowance	07/23/2009	1,530		
Edit Delete	Issue Fee Paid	08/31/2009	1,569		
	Issue Fee Paid + 4 months	12/31/2009	1,691		
Edit Delete	Patent Grant Date	03/02/2010	1,752	(61),(656) 1117	
Totals:				1,117	90
PTA:				1,027	

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